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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162370
Party	Plaintiff De Boulle Diamond & Jewelry, Inc.
Correspondence Address	SCOTT T. GRIGGS GRIGGS BERGEN LLP 901 MAIN STREET, SUITE 6300, BANK OF AMERICA PLAZA DALLAS, TX 75202 UNITED STATES
Submission	Opposition/Response to Motion
Filer's Name	Scott T. Griggs
Filer's e-mail	scott@griggslaw.com
Signature	/Scott Griggs/
Date	10/09/2007
Attachments	Opposer's Opposition and Response to Applicant's Motion to Request Discovery.pdf (8 pages)(293296 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DE BOULLE DIAMOND & JEWELRY, INC.,

Opposer,

v.

DE BEERS LV LTD.,

Applicant.

Consolidated Opposition No.: 91162370

Opposition No.'s: 91162370
91162469
91164615
91165285
91165465

OPPOSER'S OPPOSITION AND RESPONSE TO
APPLICANT'S MOTION TO REQUEST DISCOVERY

Opposer, De Boulle Diamond & Jewelry, Inc. ("Opposer" and/or "De Boulle"), hereby files this Response to Applicant's Motion to Request Discovery Pursuant to Fed. R. Civ. P. 56(f) (the "Motion to Request Discovery"), filed by Applicant, De Beers LV Ltd. ("Applicant" and/or "De Beers")¹ in this Proceeding, and in support of same will respectfully show:

I.

Procedural History

1. This Proceeding has been pending for three (3) years.
2. De Beers filed four (4) of the five (5) Applications for federal registration of the marks in issue in this Proceeding on the basis of Section 44(e) of the Trademark Act,

¹ Applicant upon information and belief changed its corporate name to De Beers Diamond Jewellers Limited, on or about November 1, 2006.

15 USC Section 1126(e) (“Section 44(e)”), on the following dates: (i) DB LOGO (78/245,219), applied May 2, 2003; (ii) DB STAR (78/245,795), applied May 5, 2003; (iii) DB SIGNATURE (78/245,210), applied May 2, 2003; and (iv) DB MONOGRAM (78/245,779), applied November 15, 2002. De Beers filed its Application for federal registration of the SO DB Mark (Reg. No. 2,985,572), based on an extension of protection of an international registration in the United States under Section 66(a) of the Trademark Act, 15 USC Section 1141(f) (“Section 66(a)”), and the Madrid Protocol Implementation Act on August 26, 2003 (the DB LOGO, DB STAR, DB SIGNATURE, DB MONOGRAM, and SO DB Marks are hereinafter collectively referred to as the “De Beers Marks”).

3. De Boulle timely filed five (5) separate oppositions against federal registration the De Beers Marks; namely, Opposition No. 91162370 (DB LOGO), Opposition No. 91162469 (DB MONOGRAM), Opposition No. 91164615 (DB SIGNATURE), Opposition No. 91165285 (DB STAR), and Opposition No. 91165465 (SO DB) (collectively the “Opposition”).

4. Pursuant to the initial Scheduling Order entered in this Proceeding on October 4, 2004 (Document No. 2), the Discovery Deadline was set to open on October 24, 2004, and expire on April 22, 2005 (the “First Discovery Deadline”). De Beers did not serve any discovery requests or attempt to take depositions in this Proceeding at any time prior to the First Discovery Deadline.

5. By Notice entered on May 2, 2005 (Document 10), the Board extended the Discovery Deadline until October 8, 2005 (the “Second Discovery Deadline”). By Notice

entered on July 20, 2005 (Document 11), the Board further extended the Discovery Deadline until December 25, 2005 (the “Third Discovery Deadline”). On November 18, 2005, more than one (1) year after discovery opened, and thirty-seven (37) days before the expiration of the Third Discovery Deadline, De Beers for the first time served its First Set of Requests for Production of Documents and Things, First Set of Interrogatories, and First Requests for Admissions on De Boule in this Proceeding (the “De Beers Discovery”). De Beers did not attempt to take depositions in this Proceeding at any time during the fourteen (14) months prior to the Third Discovery Deadline.

6. On December 27, 2005, De Beers filed a Motion to Extend Discovery and Testimony Periods (the “De Beers Extension Request”). On March 2, 2006, by Stipulation Regarding Motion to Extend Discovery and Testimony Periods, Opposer consented to the extensions requested by the De Beers Extension Request. Accordingly, by Order entered on April 11, 2006 (Document 15), the Board once more extended the Discovery Deadline until June 2, 2006 (the “Fourth Discovery Deadline”). De Beers again did not attempt to take depositions in this Proceeding at any time prior to the Fourth Discovery Deadline.

7. By Order entered on July 26, 2006 (Document 18), the Board extended the discovery deadline for the fifth time, until September 25, 2006 (the “Fifth Discovery Deadline”). De Beers again did not attempt to take depositions in this Proceeding at any time prior to the Fifth Discovery Deadline.

8. On August 9, 2007 Opposer filed its Motion for Summary Judgment in this Proceeding (the “Motion for Summary Judgment”). Thereafter, Applicant apparently contacted the Board, on an *ex parte* basis, alleging that the Motion for Summary Judgment

was untimely. On August 16, 2007 (Document 37), the Board rejected the *ex parte* allegation made by Applicant, providing Applicant an additional period of time, until September 15, 2005, to file its response to the Motion for Summary Judgment (the “Response”).

9. Applicant again took no action in this Proceeding and did not contact counsel for Opposer for almost a month. On September 12, 2007, following contact from Applicant’s counsel, Opposer’s counsel agreed, subject to the approval of the TTAB, to Applicant’s counsel’s requested extension of time to file a Response, ostensibly not for delay, but to engage in good faith settlement discussions. *See* Stipulated Motion for Extension of Time to Respond to Opposer’s Motion for Summary Judgment (the “Stipulated Extension”) (Document 40). Opposer agreed to the Stipulated Extension on the premise stated therein. At no time during their several conversations pertaining to the requested extension, did counsel for Applicant request to take any depositions for purpose of preparing the Response.

10. On September 17, 2007, four (4) days after the Board approved the Stipulated Extension, Applicant filed its Motion to Request Discovery, without consultation at all with Opposer, and no bilateral settlement discussions have ensued between the parties; notwithstanding written representations by Applicant’s counsel to Opposer and the Board in the Stipulated Extension.

11. In support of the Motion to Request Discovery, Applicant alleges that it cannot respond to the Motion for Summary Judgment, unless it is granted leave to take the deposition of Denis J Boule.

12. Applicant offers no explanation in its supporting affidavit reciting any efforts previously made to obtain the discovery sought, or any grounds for the failure to have conducted the alleged essential discovery sooner to merit the requested relief.

II.

Applicant has not shown sufficient cause for requesting
a deposition for the first time after three years

13. For a party to mandate relief under Rule 56(f), the movant must have exercised due diligence in discovery. *Baker v. Am. Airlines, Inc.*, 430 F.3d 750, 756 (5th Cir. 2005); *Gualandi v. Adams*, 385 F.3d 236, 244 (2d Cir. 2004). The trial court need not aid non-movants who have occasioned their own predicament through sloth. *Wichita Falls Office Assocs. v. Banc One Corp.*, 978 F.2d 915, 919 (5th Cir.1992).

14. Mr. Boulle's knowledge of facts relevant to this case, and his designation as an expert witness, was disclosed to Applicant in responses to Interrogatories served in this case, as early as May 2006², yet Applicant failed to request his deposition in this Proceeding; indeed Applicant did not attempt to take a single deposition since discovery opened on October 4, 2004, until the deadline for completion of discovery, almost three years later, on September 25, 2006.

15. Applicant claims as the reason for requiring the deposition that: "De Boulle claims that it has used DB as a trademark, since December 2000. There is no evidence that DB was actually used as a mark, or functioned as a trademark since December 2000, as

² See Opposer's Response to Applicant's Motion for Discovery Sanctions, filed in this Proceeding on January 31, 2007 (Document 21), Exhibit "F", Answer to Interrogatory No.'s 32, 33, 34, 35, 36, 37, 38, 39, 40.

claimed by De Boulle.” The allegation is completely unsupported by the discovery responses and the public record in proceedings before the United States Patent and Trademark Office (the “USPTO”), and is clearly made by Applicant solely for delay only. Examples of De Boulle’s use in commerce of its marks, including its DB mark, have been of public record in proceedings before the USPTO, and examined by the USPTO as part of Opposer’s application for federal registration of the Mark “DB”, U.S. Trademark Application Serial No. 78/604,056 (the “DB Mark”), Opposer’s application for federal registration of the Mark “DE B” and Design, U.S. Trademark Application Serial No. 78/440,907 (the “DE B Mark”), now US Registration No. 3,078,627, and Opposer’s application for federal registration of the Mark “DE BOULLE”, U.S. Trademark Application Serial No. 78/444,880 (the “DE BOULLE Mark”), now US Registration No. 3,078,625. Furthermore, Opposer has produced more than 1,300 pages of documents and tangible things, in response to written discovery served by De Beers in this case, including, photographs, and samples of its marks as used in commerce on labels, wrapping, advertising, store displays, web pages, invoices and the like.

16. In addition, to obtain relief under Rule 56(f), a party must recite the efforts previously made to obtain those facts, and show good grounds for the failure to have discovered the essential facts sooner. *See Theisen Vending Co., v. United States*, 58 Fed. Cl. 194, 197–98 (2003); *Baker*, 430 F.3d at 756. Applicant offers no explanation of its efforts previously made to obtain the discovery sought, or any grounds for the failure to have conducted the alleged essential discovery sooner, to merit the requested relief.

17. The grating of summary judgment in this Proceeding, should the Board

deem it proper, would therefore not be premature or improvident, and Applicant's Motion to Request Discovery should be denied.

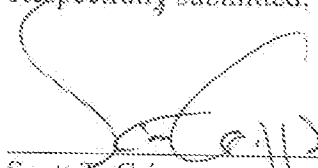
III.

Prayer

Opposer, De Boulle Diamond & Jewelry, Inc., therefore respectfully prays that the Motion to Request Discovery in all things be denied, and that the Board grant it such other and further relief, legal and equitable, general and special, to which De Boulle may show itself justly entitled.

This the 9TH day of October, 2007.

Respectfully submitted,



Scott T. Griggs
Texas State Bar No. 24032254
Griggs Bergen LLP
Bank of America Plaza
901 Main Street
Suite 6300
Dallas, Texas 75202
214-653-2400 – [telephone]
214-653-2401 – [telecopier]

Counsel for Opposer

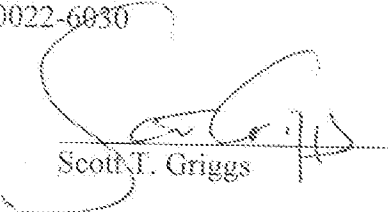
CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record by electronic mail and by mailing a true copy thereof, through the United States Mail, first class, postage prepaid, on this the 9th day of October, 2007, and addressed as follows:

Darren W. Saunders, Esq. (Darren.saunders@klgates.com)
Vincent P. Rao, II, Esq. (Vincent.rao@klgates.com)

-AND-

Darren W. Saunders, Esq.
Vincent P. Rao, II, Esq.
Kirkpatrick & Lockhart Preston Gates Ellis LLP
599 Lexington Avenue
New York, NY 10022-6030


Scott T. Griggs